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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,026	02/20/2002	Nabil M. Lawandy	109960.232US2	1908

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BOSTON, MA 02109

EXAMINER

ANGEBRANDT, MARTIN J

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

006

**Office Action Summary**

Application No.

10/082,026

Applicant(s)

LAWANDY, NABIL M.

Examiner

Martin J Angebranndt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 May 2003 and 02 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 & 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/67085 A (LAWANDY et al.).

WO 99/67085 A (LAWANDY et al.) teaches in embodiment 4, a layer for rendering an optical recording medium unreadable over time. The medium is a polymeric layer containing silica gel (an absorbent/scavenger material) and benzyl alcohol. After time the polymeric layer becomes crazed and cloudy. (page 28/line 34-29/6). The use of two or more layers based upon evaporation is disclosed. (29/8-34). Example 3 tests the process by sealing the material in a ziplock bag. (28/4-31). The use of sublimation of acid or base producing materials or from a solution entrained in a polymeric layer is disclosed. The use of gasses dissolved in water, which change in pH due to the evolution and evaporation of the gas is disclosed. This is also disclosed as being used to detect various compounds, including amines and carbon dioxide. (30/4-32). With respect to figures 6, the reference teaches the use of a diffusion barrier together with a layer, which contains oxygen and a photoinitiator/photosensitizer, which generates singlet oxygen upon irradiation. (20/11-22/15) The use of two different solvents having different polarity and volatility together with colorless dyes and a polar polymer is disclosed. The polyhydroxystyrene polymer is disclosed as able to cause coloration as well and the mixture remains colorless until the solvent is removed. (25/27-27/11). The use of various solvents is disclosed, including NMP (27/2), acetone (21/32), methanol (21/30) and other solvents. The use

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of an overlayer permeable to the evaporative process is disclosed. (29/20-25)

It would have been obvious to one skilled in the art to modify the process of the examples by providing the layers on an optical recording medium as it is disclosed as this is the desired purpose. Further, it would have been obvious to modify these by providing a permeable overlayer based upon the direction to do so on page 29 at lines 20-25. This overlayer would provide protection to the underlying layers from mechanical/contact damage. When some of the solvent is present in that layer (the layer is at a concentration equilibrium with the adjacent layer), the migration of solvent is hindered as set forth in Fick's law of diffusion and due to the physical presence of a layer.

3. Claims 1-9 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawandy et al. '262.

Lawandy et al. '262 teaches with respect to example 3 a color changing layer with various thickness of barrier layers on top of the color forming layer (10/35-60). The use of these means to prevent readout of optical recording media after a period of time is disclosed throughout.

It would have been obvious to one skilled in the art to modify the invention example 3 by placing it on an optical recording medium based upon the disclosure to do so to provide the disclosed protection from readout after a period of time.

4. Claims 1-9 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawandy et al. '892.

Lawandy et al. '892 teaches with respect to example 3 a color changing layer with various thickness of barrier layers on top of the color forming layer (5/1-31). The use of these

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means to prevent readout of optical recording media after a period of time is disclosed throughout.

It would have been obvious to one skilled in the art to modify the invention example 3 by placing it on an optical recording medium based upon the disclosure to do so to provide the disclosed protection from readout after a period of time.

5. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of WO 99/67085 A (LAWANDY et al.), Lawandy et al. '262 or Lawandy et al. '892, in view of JP 05-159366.

JP 05-159366 teaches that the provision of a polysiloxane layer reduces, but does not eliminate the corrosion caused by water, thereby indicating the polysiloxane protective layers are permeable.

In addition to the above, the examiner holds that it would have been obvious to modify the invention of either of WO 99/67085 A (LAWANDY et al.), Lawandy et al. '262 or Lawandy et al. '892 as set forth above by using other protective layer materials known to be permeable, such as polysiloxanes taught by JP 05-159366, with a reasonable expectation of achieving the functionality of the copy protection discussed in those references.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-9 and 11-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-27 and 34 of U.S. Patent No.

6,489,892. Although the conflicting claims are not identical, they are not patentably distinct from each other because they seek coverage for the same embodiments.

8. Claims 1-9 and 11-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-20 of U.S. Patent No. 6,531,262.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they seek coverage for the same embodiments.

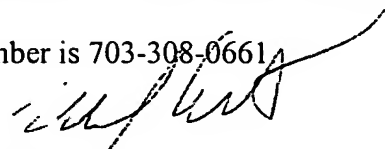
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J Angebrannndt whose telephone number is 571-272-1378.

The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9309 for regular communications and 703-872-9309 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661



Martin J Angebranndt  
Primary Examiner  
Art Unit 1756

December 22, 2003